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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,740	11/06/2001	Robert C. Chang	SANDP011	9137
26541	7590	06/15/2005		
RITTER, LANG & KAPLAN P.O. BOX 2448 SARATOGA, CA 95070			EXAMINER WOOD, WILLIAM H	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/005,740

**Applicant(s)**

CHANG ET AL.

**Examiner**

William H. Wood

**Art Unit**

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Claims 1-30 are pending and have been examined.

#### ***Allowable Subject Matter***

The indicated allowability of claims 3 and 13-14 are withdrawn upon further view of the current claim language and the cited prior art. Rejections follow.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-7, 11-12, 15-17 and 26-27 are rejected under 35 U.S.C. 102(a) as being anticipated by **Graham** et al. (WO 01/78020 A1). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same. Were appropriate, additional elements will be addressed.

#### **Claims 1, 11 and 13**

**Graham** disclosed firmware, for controlling the execution of instructions by control functions in the memory storage device (*page 38, lines 7-10; page 37, lines 18-22; page 39, line 28 to page 40, line 2*).

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Claims 2 and 26

**Graham** disclosed the method of claim 1 further including:

embedding the new firmware into a first command, wherein sending the new firmware from the host to the reader includes sending the first command from the host to the reader (*page 38, line 27 to page 39, line 2*).

Claim 3

**Graham** disclosed the method substantially the same as claim 1 and 2. **Graham** further disclosed extracting the embedded new firmware from the first command, wherein the reader extracts the embedded new firmware (*page 39, lines 1-2*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Graham et al.** (WO 01/78020 A1) in view of **Datar et al.** (US Patent Publication 2002/0137501 A1). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Graham** et al. (WO 01/78020 A1) in view of **Pua** et al. (US Patent Publication 2002/0194403). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Graham** et al. (WO 01/78020 A1) in view of **Data** et al. (US Patent Publication 2002/0137501 A1) in view of **Pua** et al. (US Patent Publication 2002/0194403). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Graham** et al. (WO 01/78020 A1) in view of **Watanabe** (USPN 6,148,366). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same. Were appropriate, additional elements will be addressed.

Claim 30

**Graham** and **Watanabe** disclosed the method of claim 28 wherein the at least first bit is arranged to substantially cause the firmware associated with the reader to set an internal flag to indicate that the in-system-programming updated of the firmware is supported (*Watanabe: figures 3-4*).

***Response to Arguments***

Applicant's arguments filed 10 February 2005 have been fully considered but they are not persuasive. Applicant argues: <sup>1)</sup> no disclosure by **Graham** of firmware for controlling execution of instructions by control functions; <sup>2)</sup> no disclosure of replacing installed firmware; <sup>3)</sup> **Watanabe** does not transfer commands for sending firmware; <sup>4)</sup> **Datar** fails to teach firmware for controlling execution of instructions by control functions; and <sup>5)</sup> no disclosure in **Datar** of in-system-programming for updating firmware.

First, under the broadest reasonable interpretation of "firmware controlling execution of instructions by control functions in the memory device", the claimed invention does read upon **Graham**. The cited prior art clearly controls instruction execution through the use of the Applications that are updated. Furthermore, those Applications naturally contain "control functions" which work upon the data and other Application of the firmware. In at least one example, **Graham** indicates data to be loaded to the cards, which will effect the execution of the Applications through their control functions (page 37, lines 18-22).

Second, **Graham** indicates updating and revising applications (page 8, line 18). A revised updated application will render the previous application version or at least the individual application elements versions unnecessary and thus, replaced.

Third, the argument is moot in view of new rejection.

Fourth and Fifth, **Datar** clearly discloses firmware, which of course controls its execution of instructions (page 3, paragraphs 0030-0031) under the broadest reasonable interpretation of such a limitation. As indicated previously, in-system-

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programming is clear through at least Flash memory, which can be reprogrammed in the system, not leaving.

Therefore, having addressed the concerns raised by Applicant in the remarks filed, the rejections are maintained as above indicated.

### ***Conclusion***


Rejection is made Non-Final.

### ***Correspondence Information***

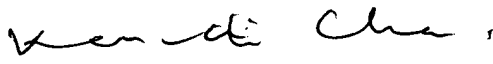
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

  
William H. Wood  
June 13, 2005



  
**KAKALI CHAKI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**